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In re Application of BLACKBURN
U.S. Application No.: 10/526,838
PCT Application No.: PCT/AU03/01096
Int. Filing Date: 27 August 2003
Priority Date Claimed: 03 September 2002
Attorney Docket No.: 75390-010100
For: LATCH ASSEMBLY WITH DEAD LATCH
INDICATOR

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(b)" filed 10 April 2006.

BACKGROUND

On 27 August 2003, applicant filed international application PCT/AU03/01096, which claimed priority of an earlier Australia application filed 03 September 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 March 2004. The thirty-month period for paying the basic national fee in the United States expired on 03 March 2005.

On 03 March 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 September 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 10 April 2006, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that the sole inventor Mark Blackburn cannot be found. The petition sufficiently demonstrates that a diligent effort was made to locate Blackburn. Specifically, several attempts were made to contact Blackburn by mail, by telephone, and through his former colleagues (see affidavit of Hans Jurgen Esser). Thus, it can be concluded with reasonable certainty that Blackburn cannot be reached.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, the declaration submitted with the petition is improper. Specifically, the declaration fails to state the name and citizenship of the inventor as required by 37 CFR 1.497(a)(3).

Furthermore, MPEP 324 states that when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, item (C) above applies. With respect to item (C), MPEP 409.03(f) states,

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

The petition states that petitioner has proprietary interest in the present invention as evidenced by an employment agreement (see Exhibit B). However, a review of the employment agreement revealed no indication that inventions made during Blackburn's employment are the property of petitioner. Accordingly, petitioner must provide an appropriate legal memorandum along with an affidavit of the person with firsthand knowledge of the facts contained therein as described above.

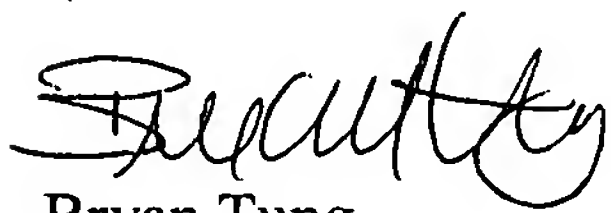
With regard to item (6) above, the petition makes an adequate showing with respect to the preservation of the rights of the parties and/or the prevention of irreparable damage.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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